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OFFICE OF PETITIONS

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In re Application of :
Merriman, et al. : **DECISION ON PETITION**
Application No. 09/577,798 : **UNDER 37 CFR 1.183**
Filed: May 24, 2000 :
Attorney Docket No. **16113-1341RE9** :

This is in response to the "Petition under 37 CFR 1.47(a)", filed December 23, 2011. The petition will be treated as a petition under 37 CFR 1.183 seeking waiver of 37 CFR §§ 1.67 and 1.175 where it requires that a supplemental declaration be executed by the named inventors in a broadening reissue application.¹

The petition is dismissed.

On May 24, 2000, the present application was filed as an application for reissue of U.S. Patent No. 5,948,061 by inventors Merriman and O'Connor who executed an original reissue declaration on August 28, 2000.

During the prosecution of the present application, the Office required a supplemental declaration with a "no deceptive intent" clause for the changes made after a declaration was filed on June 3, 2002.

The instant petition was filed on December 23, 2011. Petitioner asserts inventor Merriman has either constructively refused to sign the supplemental reissue declaration or cannot be located. It is noted that provisions of 37 CFR 1.47 do not apply in this instance and said provisions are only applicable to the original filing of the reissue declaration under 37 CFR 1.175—such filing was made on August 28, 2000. However, the requirements for establishing that a non-signing inventor has refused, or cannot be located, to sign the supplemental declaration are the same as the requirements of 37 CFR 1.47, as set forth in Section 400 of the Manual of Patent Examining Procedure. The undersigned is unsure as to whether petitioner is asserting that the non-signing inventor cannot be located or whether the non-signing inventor's conduct is to be interpreted as a refusal to join the prosecution of the application. If petitioner is asserting that the non-signing inventor cannot be located, section 409.03(d) of the *Manual of Patent Examining Procedure* provides guidance as to what will suffice as sufficient proof that the non-signing inventor cannot be reached as is alleged in the instant petition. This section states, in pertinent part, as follows:

[w]here inability to find or reach a nonsigning inventor "after diligent effort"
is the reason for filing under 37 CFR 1.47, a statement of facts should be
submitted that fully describes the exact facts which are relied on to establish that

¹ Once an application has received a fully executed oath or declaration that has been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply. Rather, the remedy for treating an inventor's refusal to also sign a supplemental oath or declaration is waiver of 37 CFR 1.67. See MPEP 603.

a diligent effort was made.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as Internet searches, certified mail, return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts.

The renewed petition should detail the steps taken to locate the whereabouts of the non-signing inventor, i.e., explain how petitioner obtained the last known addresses for the inventor and provide any documentary evidence that petitioner may have that would support the fact that the address to which petitioner sent the package is the most recent address for the non-signing inventor petitioner could obtain

If petitioner is asserting that the non-signing inventor's actions are tantamount to a refusal to sign the declaration, petitioner must demonstrate that the petitioner provided the non-signing inventor with a complete copy of the application papers. Section 409.03(d) of the *Manual of Patent Examining Procedure* provides, in pertinent part, that:

[a] refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not, itself, suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor : . .

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

The instant petition and documentary evidence suggest that only the Reissue Application Declaration was sent to the non-signing inventor. If a constructive refusal is alleged, the renewed petition should make clear that a complete copy of the application papers was sent to the non-signing inventor.

The fee for the instant petition is \$400.00, not \$200.00. Deposit account 06-1050 will be charged and additional \$200.00 accordingly.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
 Commissioner for Patents,
 PO Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
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Office of Petitions